

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

Filed by: Trial Section merits Panel  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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SADAMI YAMADA, NOBUYOSHI NAKAJIMA,  
MASAAKI OHTSUKA, and SHUJI KUHARA  
Junior Party,  
(Patent No. 5,237,358)<sup>1</sup>

v. (Count 1)

HENRI A. PRIMO and JURGEN MULLER  
Senior Party,  
(Application 08/580,389)<sup>2</sup>

and

HENRI A. PRIMO and JURGEN MULLER  
Junior Party,  
(Application 08/580,389),

v. (Count 2)

SADAMI YAMADA, NOBUYOSHI NAKAJIMA,  
MASAAKI OHTSUKA, and SHUJI KUHARA  
Senior Party  
(Patent No. 5,237,358)

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Patent Interference No. 104,320

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<sup>1</sup> Assigned to Fuji Photo Film Co., Ltd.

<sup>2</sup> Assigned to Agfa-Gevaert, N.V., a Belgium Corporation.

Interference No. 104,320  
Yamada v. Primo (Count 1)  
Primo v. Yamada (Count 2)

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**JUDGMENT**

This interference was declared on December 24, 1998, with counts 1 and 2. As was clarified in Paper No. 22, because of different benefit dates accorded to count 1<sup>3</sup> and count 2<sup>4</sup>, party Primo is senior party for count 1 but junior party for count 2, and party Yamada is senior party for count 2 but junior party for count 1. Moreover, because of the relationship in subject matter between counts 1 and 2, each party has claims which correspond to both counts 1 and 2, i.e., party Primo's claims 11, 12, 14, 15, 16, 22 and 23, and party Yamada's claims 1, 2 and 3. As was expressly stated on page 42 of the Notice Declaring the Interference (Paper No. 1):

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<sup>3</sup> As for count 1, Primo's involved application 08/580,389, filed December 28, 1995, has been accorded the benefit of application 08/376,441, filed January 23, 1995, application 07/989,364, filed December 11, 1992, application 07/682,388, filed April 9, 1991, and EP 90200969.5, filed April 19, 1990.

<sup>4</sup> As for count 2, Primo's involved application 08/580,389, filed December 28, 1995, has been accorded the benefit of application 08/376,441, filed January 23, 1995, and application 07/989,364, filed December 11, 1992.

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For these claims [which correspond to both counts 1 and 2], the prevailing party on priority with respect to count 2 would prevail, unless the opposing party prevails with respect to count 1.

As to count 1, party Yamada has conceded priority to party Primo. (Paper No. 30). Under 37 CFR § 1.662(a), the concession of priority is treated as a request for entry of adverse judgment. The request is granted.

As to count 2, party Primo has conceded priority to party Yamada. (Paper No. 29). Under 37 CFR § 1.662(a), the concession of priority is treated as a request for entry of adverse judgment. The request is granted.

Although Yamada is the prevailing party with respect to count 2, Yamada is not entitled to those Yamada claims which correspond to both counts 1 and 2, and Primo is entitled to those Primo claims which correspond to both counts 1 and 2, because party Primo has prevailed with respect to count 1.

Judgment as to the subject matter of count 1 is hereby awarded to party Primo. Accordingly, Sadami Yamada, Nobuyoshi Nakajima, Masaaki Ohtsuka, and Shuji Kuhara are not entitled to their claims 1, 2 and 3 of Patent No. 5,237,358, which correspond to count 1. On this record, Henri A. Primo and

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Jurgen Muller are entitled to their claims 11, 12, 14, 15, 16, 22 and 23 of application 08/580,389, which correspond to count 1.

Judgment as to the subject matter of count 2 is hereby awarded to party Yamada. Accordingly, Henri A. Primo and Jurgen Muller are not entitled to their claims 19 and 20 of application 08/580,389, which correspond solely to count 2. On this record, Sadami Yamada, Nobuyoshi Nakajima, Masaaki Ohtsuka, and Shuji Kuhara are entitled to their claims 5-9 of Patent No. 5,237,358, which correspond solely to count 2.

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Richard E. Schafer )  
Administrative Patent Judge)

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Jameson Lee )  
Administrative Patent Judge)

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Richard Torczon )  
Administrative Patent Judge)

BOARD OF PATENT  
APPEALS  
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Interference No. 104,320  
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Primo v. Yamada (Count 2)

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